

E2 33. (Amended) ~~The [composition]~~ method of claim 30 wherein said composition further [comprising] comprises a cytokine.

Remarks

Support for the present amendments can be found at least at page 69, lines 1 through 6.

The Office Action

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,005,080 to Snodgrass et al. (the '080 patent), which "claims antibodies to the hematopoietin receptor." The Examiner explicitly concedes that "the patentee was not aware of the fact that their receptor was the leptin receptor and that antibodies to such could also be used to modulate weight." However, the Examiner states that "despite such, the claims would still have been prima facie obvious from the prior art, despite the presence of functional language, because the physical characteristics of the claimed antibody appears to be the same or substantially the same as that of the patent."

Applicants have cancelled claims 13-21, thus obviating their rejection. The remaining claims have been amended. All of the amended claims recite or depend from claims that recite the testing of antibodies for the "ability to decrease body weight or fat-depot weight or food intake in an obese animal." Applicants respectfully submit that, as Snodgrass et al. were unaware that antibodies specifically binding to their receptor might have these properties, as recognized by the Examiner, they had no motivation to produce and test antibodies in order to identify those that have the ability to decrease body weight or fat-depot weight or food intake in an obese animal. Accordingly, the amended claims are clearly both novel and unobvious, and are thus allowable.

Further comments on the Snodgrass et al. patents

The '080 patent cited in the present Office Action is a divisional of Application No. 08/355,888, which matured into U.S. Patent No. 5,763,211 (the '211 patent). With regard to the

'080 patent, the Examiner stated that "the disclosure of this new divisional patent is the same as the parent, which disclosure has been set forth in the previous Office Action of Snodgrass et al. ('211)." Upon more careful review of the disclosures of these two patents, Applicants would like to take this opportunity to clarify the record with respect to the Snodgrass et al. '211 patent.

The '211 patent is a continuation-in-part of Serial No. 08/306,231, which matured into U.S. Patent No. 5,643,748 to Snodgrass et al. (the '748 patent). The '748 patent was first cited by the Examiner in the Office Action issued October 24, 1997 (Paper No. 6). This patent discloses a partial clone of a hematopoietin receptor, as Applicants pointed out in their response filed January 26, 1998, stating "This patent fails to show any full length receptor sequence..." (page 5, last paragraph). The Examiner recognized this in the Office Action of May 27, 1998 (Paper No. 11), conceding "that the prior art did not disclose the full length clone of their hematopoietin receptor..." (page 3, first paragraph).

The '211 patent was brought to the Examiner's attention in an Information Disclosure Statement filed by Applicants on July 7, 1998. The Examiner acknowledged this reference in the next communication, the Office Action of December 21, 1998, by including a copy of the initialed Form 1449. However, the '211 patent did not appear to become part of the prior art rejections. Rather, the Examiner maintained the rejections under Snodgrass without identifying the specific Snodgrass et al. references and again conceded that the prior art did not disclose the full length clone (page 3, carryover paragraph). Thus in the Preliminary Amendment, filed January 25, 2000, Applicants refer to the prior art rejection over the '748 patent and again state that "Snodgrass et al. disclose a partial clone..." (page 2, fourth paragraph).

The '211 patent is first clearly cited in the Office Action mailed April 5, 2000. The Examiner stated that "Claims 1-33 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snodgrass et al. ('748 or '211 or '610)." However, the Examiner again conceded that "the prior art did not disclose the full length clone of their hematopoietin receptor..." In view of this, Applicants also failed to note the differences between the disclosure of the '211 patent and the earlier cited '748 patent, and in their response of August 24, 2000, again submitted that Snodgrass et al. did not disclose a full length clone.


In reviewing all of the cited Snodgrass et al. patents ('748, '211 and '610) in light of the current Office Action, Applicants became aware that the '211 patent does, in fact, disclose a full length receptor. Applicants regret the unintentional, inadvertent mischaracterization of the '211 patent in their earlier response, which was done without any deceptive intent, but submit that the added disclosure in the '211 patent has no bearing on the patentability of the claims pending in the present application.

It is believed that the amendments outlined hereinabove place all pending claims in condition for allowance, and an early action to that effect is respectfully solicited.

Respectfully submitted,

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